In the United States Patent and Trademark Office

In re the Application of:

Janani Janakiraman	)	
Serial Number: 09/994,518	)	Group: 3625
Docket Number: AUS920010653US1	)	Examiner: Yogesh C. Garg
Filed on: 08/31/2001	)	
For: "Dynamic Content Configuration	)	
for Microbrowsers by State, Resource	)	
Allocation and User Preferences"	)	

REPLY BRIEF

Response to Examiner's Action

This Reply Brief is filed responsive to receipt of the Examiner's Action dated May 21, 2007.

Real Party in Interest

The subject patent application is owned by International Business Machines Corporation of Armonk, NY.

Related Appeals and Interferences

None.

Status of Claims

Claims 1 - 21 are currently withdrawn from consideration responsive to a restriction requirement. Claims 22 - 29 are finally rejected, the rejections of which are appealed.

Status of Amendments after Final Rejections

An amendment to Claims 22, 28 and 34 to present them in better condition for consideration on Appeal was submitted on April 26, 2007, and has been accepted by the Examiner. This amendment corrected a typographical error and a terminology synonym consistency issue.

Summary of the Claimed Subject Matter

The present invention provides a method and system for extending the battery life of mobile web browsing device, such as a personal digital assistant (PDA) or cell phone, by detecting when the mobile device's battery is low, and then restricting the downloading of web page objects to avoid downloading "non-essential" web objects. By eliminating the downloading of non-essential web objects, power usually consumed by the receiver circuit to receive those non-essential web objects is reduced, thereby allowing extended life of the battery without substantial detrimental impact to the user of the information downloaded.

Please refer to the Appeal Brief, filed April 27, 2007, for complete details regarding the independent claims.

Grounds for Rejection For Which Review is Sought

In the Appeal Brief, Appellant requested review by the of:

(A) the rejections of Claims 22 - 34 under 35 U.S.C. §112, first paragraph;

(B) the rejections of Claims 22 - 39 under 35 U.S.C. §112, second paragraph;

(C) the rejections of Claims 22 - 39 as being unpatentable over U.S. Patent 6,493,758 to McLain (hereinafter "McLain") in view of US Patent 6,108,316 to Agrawal *et al.* (hereinafter "Agrawal").

In the Examiner's Answer, dated, May 21, 2007, rejections (A) of Claims 22 - 34 under 35 U.S.C. §112, first paragraph; and (B) of Claims 22 - 39 under 35 U.S.C. §112, second paragraph, were withdrawn.

Appellant maintains a request for Board review of the rejections of Claims 22 - 39 as being unpatentable over U.S. Patent 6,493,6758 to McLain in view of Agrawal.

Arguments

Opening Items

In the Examiner's Answer, items (1) through (8), starting on page 3, appear to be correct, except for a typographical error indicating that the relied upon patent by McLain is number 6,493,6758. It should read 6,493,758.

Grounds for Rejection

Item (9) in the Examiner's Answer, starting on page 4, appears to be a verbatim reproduction of the rationale for the rejections from the Office Action dated November 28, 2006, including those withdrawn in the Examiner's Answer. Appellant was not notified of any new grounds of rejection in this Item of the Examiner's Answer. Further, no change in the rationale was readily apparent.

Thus, Appellant maintains all arguments presented in the Appeal Brief. If a change in position or rationale or a new ground of rejection was presented in this section of the Examiner's Answer, Appellant respectfully requests the Examiner to clarify and point out these changes or additions.

Examiner's Responses to Appeal Brief Arguments

In Item (10) of the Examiner's Answer, starting on Page 7, the Examiner has responded to the arguments made in the Appeal Brief by the Appellant.

Rejections of Claims 22 - 34 under 35 U.S.C. §112, First Paragraph

In the Final Office Action, Claims 22 - 34 were rejected under 35 U.S.C. §112, first paragraph, for failing to comply with the written description requirement with respect to the step "providing a web server with at least two sets of web objects for a web page including at least a set of web objects previously designated as essential objects".

Item (10)A. of the Examiner's Answer on page 7 indicates the Examiner has withdrawn these rejections. Appellant appreciates this reconsideration.

Rejections of Claims 22 - 39 under 35 U.S.C. §112, Second Paragraph

In the Final Office Action, newly issued rejections of Claims 22 - 39 under 35 U.S.C. §112, second paragraph, were made for lack of antecedent basis for the term "said advertisement" web object set, which appears in independent claims 22, 28, and 34.

Item (10)A. of the Examiner's Answer on page 7 indicates the Examiner has withdrawn these rejections. Appellant appreciates this reconsideration.

Rejections of Claims 22 - 39 under 35 U.S.C. 103(a) over McLain in view of Agrawal

In the Office Action prior to Final Office Action, claims 22 - 39 were rejected over a proposed combination of McLain and Agrawal. It was stated in the rationale of the Office Action for the rejections that McLain does not teach receipt by a server of a low battery condition from the client device (pg. 10), so it was proposed Agrawal's teaching of receipt of a battery condition and taking some sort of response to the low battery condition would have been obvious to combine with McLain's teaching.

Due to the following errors in interpretation of the cited references, errors in the assessment of the scope of the claim terms, and errors in the holding of what would have been obvious to an ordinarily skilled artisan at the time the invention was made, the that combination and modifications proposed by the Examiner represent an unreasonable leap that would not have been obvious to make at the time of the invention. In order for an ordinarily skilled artisan to have made this leap in reasoning, such a person would have had to recognize and substitute as equivalent (1) prioritization of transmission of elements for restriction of transmission of elements, which is not actually equivalent; (2) battery capacity and memory capacity swapped for variable battery level, which is not actually equivalent; (3) minimization of battery energy consumption as an alternative objective of an invention directed towards other objectives; and (4)
substituting characteristics of usable/irrelevant objects with characteristics of essentiality/nonessentiality, which is not actually equivalent.

Prioritization Not the Same as Restriction of Transmission. It was summarized in the Office Action by the examiner that combining McLain with Agrawal would yield a server system which would receive a low battery condition and would *prioritize* web objects for transmission to the client under low battery conditions "before the battery becomes dead."

However, Appellants pointed out in the Appeal Brief that "prioritization" of web objects for transmission (e.g. changing the order in which they are transmitted) is not the same operation of Appellants' system or claims (e.g. blocking the transmission of certain web objects).

Time-varying Battery Level Not Taught by McLain. In the Appeal Brief, Appellant pointed out that the claims are directed towards methods for restricting the information transmitted from a server to a mobile device based upon battery level, which is a time varying condition. Appellant argued that McLain's technology, however, is directed towards restricting the information transferred to a mobile device based upon a non-variable condition, namely memory capacity. Memory capacity would not change over time for a particular device, and thus McLain would not contain a suggestion to adapt or modify to determine which information objects to transfer based upon a variable condition such as battery condition.

In the Examiner's Answer, the Examiner has responded to this argument:

> In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See In re Keller, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); In re Merck & Co., 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). In the instant case, the examiner has combined the teachings of both McLain and Agrawal to arrive at the claimed invention of independent claim 22 and therefore the applicant's piecemeal arguments against McLain and Agrawal are not persuasive.

Appellant respectfully submits that this is an erroneous application of the cited case law. Appellant respectfully objects to the mischaracterization of the presented arguments as "piecemeal" as being misleading and inaccurate. Examiner's position appears to be that somehow the Appellant is not allowed to address the proposed combination which is comprised

of selectively culled individual elements from two references, and which appears to imply that the Appellant must somehow restrict the arguments for patentability to the combination.

The fact that the Examiner has proposed and alleged obviousness under 35 U.S.C. 103(a) of only certain selected components drawn from multiple, unrelated references (e.g. different inventors, different assignees, different classes) leads to the nature of Appellant's arguments because the alleged combination does not in fact exist, and the alleged combination does not in fact include all of the components from all of the references.

Appellant further respectfully submits that the Examiner's statement ". . . [i]n the instant case, the examiner has combined the teachings of both McLain and Agrawal to arrive at the claimed invention of independent claim 22 . . . " is inaccurate, whereas the Examiner has relied upon the teachings of the Appellants disclosure to interpret the references overly broadly.

Appellant respectfully submits that the cited case law does not relieve the burden on the Examiner to establish that the proposed combination of the two references must fairly teach all claimed elements, steps, and limitations, in order to form a *prima facie* case of obviousness. Demonstration of missing steps, elements, and limitations was made by Appellant by considering the disclosures of each reference individually. Any element, step, or limitation which is missing from both references is also necessarily missing from the combined references, and thus the argument is relative to the combination as well. The case law cited by the Examiner is ineffective at rendering the Appellant's argument moot, and the argument must be given proper weight in the consideration of the determination of patentability.

Minimization of Battery Power Not Taught or Suggested by the References

In the Appeal Brief, Appellant pointed out that the primary reference, McLain, briefly acknowledges that many portable devices are battery powered (col. 1 lines 22 - 28), but McLain does not disclose that their method minimizes battery energy consumption or extends battery life. Instead, McLain indicates that their method minimizes *wasted memory* (McLain col. 2 lines 15 - 16) for subsequent "offline browsing" (McClain col. 2 lines 20 -21, col. 3 lines 45 - 49).

Further, Appellant pointed out in the Appeal Brief that Agrawal does not teach battery life maximization using their method, either, but instead teaches *prioritizing* upload (from the mobile device to the base station) of information from the low-battery networked device in order to fully accomplish the transfers *before the battery dies* (Agrawal ABSTRACT, col. 1 lines 65 -

67). It was stated in the rationale for the rejections in the Office Action that Agrawal teaches using battery condition to "take action", but Appellant respectfully submits that Agrawal only teaches using battery condition to assign higher priority to data transmissions from the low-battery device. There is no reasonable suggestion in Agrawal that battery condition should be used for broadly "taking action", and there is no suggestion to specifically select essential web objects thereby suppressing download of non-essential web objects.

Still further, Appellant pointed out in the Appeal Brief that the claims are directed towards restricting transfers of data *from* a server *to* the mobile device (e.g. "downloading"), while Agrawal's technology is directed towards the reverse transfer of information *from* the mobile station *to* the base station (e.g. "uploading) (Agrawal ABSTRACT, col. 1 lines 59 - 61).

Appellant argued, therefore, that neither McLain or Agrawal, therefore, teaches or even suggests using battery condition (or a variable condition) as a parameter to determine which *essential* or *non-essential* web page objects to transmit or not transmit from a server to a networked client in order to extend battery life.

As discussed in the Appeal Brief, neither reference teaches or suggests use of a battery condition to block delivery of non-essential web objects, not just re-prioritize them. Therefore, the combined McLain-Agrawal reference also fails to teach these steps, elements, and limitations.

Web Objects Designated as Essential and Non-Essential Not Taught by the McLain

In the Examiner's Answer, the objections and rejections related to the claim limitations which stipulate the web objects as being "previously designated as essential objects" were withdrawn. As such, this claim limitation must be taught by the references, or the claims are not rendered unpatentable by the proposed combination.

The Examiner has not, however, responded to this argument from the Appeal Brief in the Examiner's Answer. Thus, the only standing argument to support teaching of this aspect of the claims is found in the original rationale for the rejections as noted in the Office Action, and as repeated on page 6, lines 4 - 5:

> " . . . McLain teaches providing a server with a plurality of web objects which included both essential that is relevant data and irrelevant, that is non-essential data. . . . "

Applicant respectfully disagrees, and suggests the interpretation of the McLain reference is overly broad and applies improper hindsight. McLain's use of the term "irrelevant data" relates to information components which are "unsuitable for the mobile device" or which "cannot be used":

> Another technique for "offline" browsing with a desktop computer involves traversing or "crawling" through a particular Internet site and storing the information locally. If the information is stored as pages, simple transfer of this information to the mobile device would not be efficient since the mobile device typically has limited memory resources and the information may contain **portions that cannot be used or are unsuitable for the mobile device**. Thus, memory may be wasted in storing **irrelevant information**. (McLain, col. 2, lines 8 - 16, emphasis added by Appellant).

McLain's disclosure does not use the term "irrelevant" anywhere else – this is the sole instance of the term in all of McLain's disclosure.

Appellant respectfully points out that the term "essential" does not connote the same meaning as "suitable" for a mobile device, nor does it connote "usable" for the mobile device. "Suitable" and "usable" relevant to a mobile device are perhaps more synonymous with the term "compatible", but it is well known that whether or not a particular web object is compatible with a mobile device has nothing to do with its battery level.

As a device's battery level reduces, it's *compatibility* with certain types of web objects does not change, of course. A cell phone with a fully charged battery is still capable of displaying a video clip as it is when the battery is half-charged, for example. But, a cell phone which is incapable of playing an MPEG ringtone is equally incapable when it's battery is fully charged or partially charged, for example.

Another way to consider these terms and whether or not they have a reasonable degree of synonymity is to try to graph or chart their meanings. If two terms can be graphed or charted in two independent axes, then the terms are mutually independent and can be considered non-synonymous. For example, if an object has two characteristics - color and weight - these can be plotted on orthogonal axes due to the independence of the two characteristics.

The following table provides such a demonstration of two independent axes (rows and

columns) for the terms in issue in this argument for an example mobile phone being used to view a news website:

Independence of Usefulness and Essentiality

	useful	not useful
essential	text of a news web site page for a news story which the phone is capable of displaying	a video clip which the cell phone is *incapable* of playing, but which is important to the news story
non-essential	advertisement for a premium news link which the phone is capable of showing, but which is not related to the news story	advertisement for a premium news link which the phone is *incapable* of showing, and which is not related to the news story

Specific examples can fit any combination of the characteristics and their antonyms, thus a 2-by-2 orthogonal chart or plot of the combinations is a true representation of their relationship. These examples illustrate that the two characteristics - essentiality and usefulness - are mutually independent, and are, therefore, not synonymous.

The Examiner's Answer contains no further support of how McLain's "irrelevant", unsuitable, unusable web objects are the same as Appellant's claimed "designated essential" web objects.

Further, the Examiner has argued in the final Office Action that "designation" of a web object implies a human designating an object as "essential or non-essential", or a listing of such objects. Based on this argument, is it possible for a human to simply designate a web object should be suitable or useable by a particular mobile device? This would be illogical because the suitability of a web object, or its ability to be used by a mobile device would be a factor of compatibility, not essentiality. In other words, a mobile device is compatible with certain web object types based on its circuitry and software, not based on a user designation.

Appellant respectfully submits that the Examiner has erred in this holding, and requests allowance of all pending claims.

Response to the Balance of Arguments in the Examiner's Answer

The remainder of the arguments presented in the Examiner's Answer were not enumerated to specifically correspond to the arguments in the Appeal Brief. As stated above, there is no further argument in the Examiner's Answer with respect to Appellant's contention that "previously designated as essential" is not taught by the references.

In the Examiner's Answer, starting on page 8, third paragraph, the Examiner has argued:

> "McLain teaches restricting information to be transferred to a mobile device based upon obtaining characteristic information of the mobile device pertaining to either hardware or software capabilities of the mobile device (see at least Abstract, col.2, lines 8-16 and 25-34). The hardware, when according broadest possible interpretation, includes hardware such as a memory device or battery device used to power the mobile device. Both the memory device and battery device have limited and variable capacities because with progressive use of each of them their capacities reduce. McLain has suggested to restrict transfer of irrelevant information upon obtaining characteristic information of either hardware or software capabilities of the mobile device resulting in optimization of the use of the available but limited and variable resources which can include both the memory device and the battery device. McLain, in the preferred embodiment, has referred to the memory device and not the battery device. But at the time of the applicant's invention it was known to consider the limited battery power source of the mobile device to optimize the use of the mobile device in view of its depleting power capacity (see Agrawal, Abstract and col.1, line 44-col.2, line 26 and fig.5.). Agrawal teaches in a wireless communication system that a base station in communication with the mobile terminal receives signals about the low battery condition of the mobile terminal and based upon this signal the base station is able to change the schedule of the transmission of messages from the mobile terminal with low battery. In view of McLain and Agrawal, it would be obvious to one of an ordinary skilled in the art of designing hardware and software for mobile devices working with limited and variable resources, such as memory and battery power to utilize the concepts of McLain and Agrawal to design system hardware and software to optimize the use of the variable resources including both the memory capability and battery power of the mobile devices. McLain does not teach away from combining the Agrawal's concept of taking an action to optimize the mobile device's operation upon obtaining the characteristic of depleting battery power of the mobile device."

Appellant respectfully disagrees. With respect to Examiner's statement in the Examiner's

Answer ". . . [b]oth the memory device and battery device have limited and variable capacities because with progressive use of each of them their capacities reduce", applicant must especially disagree. McLain only mentions that the battery may be rechargeable or replaceable (col. 1, lines 24 - 25), and that memory can be non-volatile through use of a back-up battery (col. 4, line 21). Appellant stipulates, of course, that discharging a battery is the inherent need for recharging or replacing a battery. However, in the context of McLain's "Offline Viewer of Internet Content on a Mobile Device" (McLain's title), how does this relate to taking an action based on the battery charge level? Is it possible that viewing content *offline* as opposed to *online* somehow saves battery consumption? If so, where is this disclosed by McLain, and how would offline viewing benefit reduced battery consumption? This is not disclosed by McLain, and is not a reasonable interpretation of the McLain disclosure. Therefore, the teachings of the McLain disclosure have been erroneously and over-broadly interpreted in order to meet the claim limitations, and the references have been interpreted using improper hindsight.

Improper Use of Hindsight to Interpret Cited References

With respect to the Examiner's statement in the Examiner's Answer " . . . [i]n view of McLain and Agrawal, it ***would be*** obvious to one of an ordinary skilled in the art . . . " (emphasis added by Appellant), this is improper hindsight. It has been recognized by the courts that the question of obviousness is not one of current perspective of what *would be* (conditional *present* tense) to do in view of the cited reference, but the question of obviousness must be resolved relative to what *would have been* (conditional *past* perfect tense) obvious to do in view of the cited reference *at the time of the invention*. This is an error in determining obviousness of using improper hindsight.

Teaching Away not a Relief from Other Factors Required to Establish Obviousness

With respect to the Examiner's statement in the Examiner's Answer that " . . . McLain does not teach away from combining the Agrawal's concept of taking an action to optimize the mobile device's operation upon obtaining the characteristic of depleting battery power of the mobile device . . . ", Appellant respectfully submits that not teaching away from a combination by the references does not relieve the requirement to teach all of the claimed steps, elements, and limitations, and for the proposed combination to have been obvious at the time of the invention

to one of ordinary skill in the art

In the Examiner's Answer, starting on page 10, first full paragraph, it was stated:

> "Claim 22 of the applicant's application simply recites limitations related to optimizing the use of mobile devices by sensing indication of the depleting capacity of at least one hardware element as disclosed in McLain and Agrawal. In McLain, based upon obtaining the characteristic of depleting memory availability of the mobile device, the transfer of content is restricted to the mobile device and in Agrawal, based upon obtaining the characteristic of depleting battery power of the mobile station, the base station changes the transmission schedule of the mobile station. In the instant case, the limitations of claim 22 extend to obvious combination of the combined teachings of McLain and Agrawal because at the time of the applicant's invention the problem of obtaining characteristic information of the mobile device pertaining to the depleting capacity of a hardware device including both the memory availability and battery power and its solution were known, as is evident from the teachings of McLain and Agrawal. Since the claim 22 limitations are within the objective reach of the prior art teachings the claim is obvious and should be rejected under 35 LISC 103."

Appellant respectfully disagrees. With respect to Examiner's statement that " . . . by sensing indication of the depleting capacity of at least one hardware element as disclosed in McLain and Agrawal . . . ", the term "depleting" or "deplete" does not appear in either reference's disclosure. Appellant respectfully submits that McLain merely states that typical mobile devices have "limited memory resources" (col. 2, line 13; col. 3 lines 62 - 63). McLain does not disclose determining an "available amount of memory", or a changing level of used memory versus unused memory, which would be relative to the dynamics of the memory.

Limited Memory is not the Same as Battery Level

Appellant respectfully submits that "limited memory" is referring to a static memory capacity (e.g. amount of installed memory, etc.). This is more analogous to "battery capacity", not to "battery level", where battery level would be some level less than battery capacity – e.g.

battery capacity less consumed energy would equal current battery level. Similarly, memory capacity less memory usage would equal current available memory.

Thus, the Examiner's holding that "depleting memory" is taught is erroneous, because only "limited memory" is taught without further definition or specification of the meaning of the term. Because the Examiner's argument depends on the analogy between "depleting memory" and "depleting battery", and because neither "depleting battery" or "depleting memory" is not explicitly taught, the reference fails to teach taking action based upon battery level.

Improper Use of Hindsight Employed to Interpret Cited References

With respect to the Examiner's statement page 10 of the Examiner's Answer, last sentence of the first full paragraph ". . . [s]ince the claim 22 limitations are within the objective reach of the prior art teaching the claim ***is*** obvious and should be rejected . . . " (emphasis added by Appellant), Appellant respectfully submits that this is additional evidence of improper hindsight being applied to the analysis of obviousness. The legal threshold of obviousness is not properly what *is* currently obvious in view of the applicant's disclosure and the prior art, but what *would have been obvious* to one of ordinary skill in the art *at the time of the invention* and in view of *only* the prior art *without* benefit of the inventor's disclosure.

With respect to the Examiner's statement on page 10 that any judgement on obviousness necessarily requires reconstruction upon hindsight reasoning, and that such reasoning is proper so long as it only takes into account knowledge which was within the level of ordinary skill in the art, Appellant recognizes this is the general guidance of the MPEP. However, this does not authorize improper hindsight. Appellant respectfully disagrees that *only* knowledge which was within the level of the ordinary skill in the art was employed in the Examiner's obviousness analysis, as evidenced by the erroneous interpretations of the references set forth in the preceding paragraphs, and evidenced by the use of present and present perfect forms of the verb "be" throughout the rationale.

Appellant's arguments were directed towards improper use of hindsight, where the references are being interpreted *in view of the Appellant's disclosure*, and where such view of the Appellant's disclosure is relied upon to unreasonably expand the references beyond their explicit

disclosures. The courts have repeatedly warned of the inappropriate, but easily and often unknowlingly-committed process of improperly using hindsight to interpret the prior art in view of an inventors disclosure, including but not limited to:

> ***In re Oetiker,*** 977 F.2d 1443, 24 USPQ2d 1443, 1446 (Fed. Cir. 1992)
> The combination of elements from non analogous sources, in a manner that reconstructs the applicant's invention only with the benefit of hindsight, is insufficient to present a prima facie case of obviousness. There must be some reason, suggestion, or motivation found in the prior art whereby a person of ordinary skill in the field of the invention would make the combination. That knowledge can not come from the applicant's invention itself.
>
> ***Iron Grip Barbell Company, Inc. v. York Barbell Company, Inc.,*** 392 F.3d 1317, 73 USPQ2d 1225, 1227 (Fed. Cir. 2004)
> We turn first to a comparison between the prior art and the claimed invention. In this inquiry, we are mindful of the repeated warnings of the Supreme Court and this court as to the danger of hindsight bias. See, e.g., Graham, 383 U.S. at 36 (consideration of secondary factors "serve[s] to guard against slipping into use of hindsight and to resist the temptation to read into the prior art the teachings of the invention in issue" (internal quotations and citations omitted)); In re Kotzab, 217 F.3d 1365, 1369 (Fed. Cir. 2000) ("[T]he very ease with which the invention can be understood may prompt one to fall victim to the insidious effect of a hindsight syndrome wherein that which only the invention taught is used against its teacher." (internal quotations omitted)). We note in this respect that the district court's use of an "overall picture" and "common sense" test of obviousness falls squarely into the hindsight trap. See In re Lee, 277 F.3d 1338, 1345 (Fed. Cir. 2002).
>
> ***Ecolochem, Inc. v. Southern Cal. Edison Co.,*** 227 F.3d 1361, 56 USPQ2d 1065, 1072-73 (Fed. Cir. 2000)
>
> > In In re Dembiczak, we noted that:
> > Measuring a claimed invention against the standard established by section 103 requires the oft-difficult but critical step of casting the mind back to the time of invention, to consider the thinking of one of ordinary skill

in the art, guided only by the prior art references and the then-accepted wisdom in the field.

In re Dembiczak, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999). We "cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention." In re Fine, 837 F.2d 1071, 1075, 5 USPQ2d 1596 (Fed. Cir. 1988).

Our case law makes clear that the best defense against hindsight-based obviousness analysis is the rigorous application of the requirement for a showing of a teaching or motivation to combine the prior art references. See *Dembiczak,* 175 F.3d at 999, 50 USPQ2d at 1617. "Combining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability - the essence of hindsight." Id. . . . Although the suggestion to combine references may flow from the nature of the problem, see *Pro-Mold & Tool Co. v. Great Lakes Plastics, Inc.,* 75 F.3d 1568, 1573, 37 USPQ2d 1626, 1630 (Fed. Cir. 1996), "defining the problem in terms of its solution reveals improper hindsight in the selection of the prior art relevant to obviousness," *Monarch Knitting Mach. Corp. v. Sulzer Morat Gmbh*, 139 F.3d 877, 880, 45 USPQ2d 1977, 1981 (Fed. Cir. 1998). Therefore, "when determining the patentability of a claimed invention which combines two known elements, 'the question is whether there is something in the prior art as a whole to suggest the desirability, and thus the obviousness, of making the combination.'" *In re Beattie,* 974 F.2d 1309, 1311-12, 24 USPQ2d 1040, 1042 (Fed. Cir. 1992) (quoting *Lindemann,* 730 F.2d at 1462, 221 USPQ at 488).

ATD Corporation v. Lydall, Inc., 159 F.3d 534, 48 USPQ2d 1321, 1329 (Fed. Cir. 1998)

Determination of obviousness can not be based on the hindsight combination of components selectively culled from the prior art to fit the parameters of the patented invention. There must be a teaching or suggestion within the prior art, or within the general knowledge of a person of ordinary skill in the field of the invention, to look to particular sources of information, to select particular elements, and to combine them in the way they were combined by the inventor.

Appellant respectfully suggests that by the nature of the applied references and the nature of the reasoning and rationale of the rejections, including the numerous failures of explicit recitation and dependencies upon interpreted equivalent terms and functionalities, it is evident that improper hindsight has been employed to maintain these rejections.

In the Examiner's Answer, starting on page 11, the Examiner has stated:

> Further, in response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See In re Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988)and In re Jones, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the examiner has combined the claimed elements from the existing teachings in McLain and Agrawal and the knowledge to suggest to combine the McLain teachings was generally obvious/available to one of ordinary skilled in the art because it was objective to extend the McLain method and system in receiving low battery power information from the mobile device so as to transfer the content to the mobile device as a function of the battery power information so as not to waste the depleting battery power by sending irrelevant information.

Appellant respectfully submits that there are several errors and improper bases for rejection presented in this statement. With respect to the Examiner's statement ". . the knowledge to suggest to combine the McLain teachings was generally obvious/available to one of ordinary skilled in the art . . . ", Appellant submits that this statement is unclear how or where motivation and suggestion were found. It is unconventional to refer to "knowledge to suggest". Is the reasoning that the suggestion itself was common knowledge?

Just following this phrase is another unclear phrase ". . . was generally obvious/available to one or ordinary skilled in the art . . . ". Is this stating that the suggestion was obvious? As such, is the net rationale stating that it *would have been* obvious *to suggest* to combine the cited elements in an *obvious* manner? This seems to be recursive logic to state that the invention

would have been obvious because it would have been obvious to suggest the combination, even though such suggestion is not found in the reference. Such reasoning, if this is indeed the proper understanding, would be improper.

With respect to the portion of the statement " . . . it was objective to extend the McLain . . . ", Appellant respectfully submits that this "objective" is not found in the references, but is gleaned from the Appellant's own disclosure using improper hindsight.

For these reasons, Appellant maintains the request for the Board's review of all rejections in view of the errors in examination as discussed in the Appeal Brief and in this Reply Brief.

Respectfully,

/ Robert Frantz /

Robert H. Frantz, Reg. No. 42,553
Agent for Applicant(s)
Tel: (405) 812-5613
Franklin Gray Patents, LLC